

S/N 09/711,578

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Nora Femenia et al.	Examiner:	Pierre Elisca
Serial No.:	09/711,578	Group Art Unit:	3621
Filed:	November 13, 2000	Docket No.:	2043.003US1
Customer No.:	49845	Confirmation No.:	7170
Title:	AUTOMATED CROSS-CULTURAL CONFLICT MANAGEMENT		

APPELLANTS REPLY BRIEF UNDER 37 C.F.R. 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This reply brief is sent in response to the Examiner's Answer, mailed December 11, 2008, which was sent in answer to Appellants' Appeal Brief, filed August 8, 2006. Appellants' Appeal Brief was filed in response to the rejection of claims 1-8, 10-18, and 20 of the above-identified application.

The entire delay in filing the present reply from due date for the reply until the filing of this Petition was UNINTENTIONAL. Per 37 CFR 41.39(b), Appellants respectfully request that the prosecution be reopened before the Examiner and that the amendments and appended remarks contained herein be considered.

The Commissioner is authorized to charge the Petition Fee of \$1620.00 due under 37 CFR §1.17(m), and any other fees which may be due, to Deposit Account No. 19-0743.

A notification that the Petition is accepted and that the patent application is revived is respectfully requested.

IN THE CLAIMS

Please amend the claims as follows. Added text is underlined and deleted text is either struck through or shown in double enclosing brackets. Appellants aver that no new matter has been added.

1. (Currently Amended) A method of managing a dispute about a pre-existing agreement, comprising:

automatically receiving, over a network by a system computer, information relating to the dispute, the information being generated from one of an initiator computer associated with an initiator and a respondent computer associated with a respondent, the initiator and the respondent being parties to the agreement;[[,]] and

iteratively providing portions of the information to the other of the initiator computer and the respondent computer in accordance with predetermined criteria, the predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration.

2. (Original) The method of claim 1, further comprising automatically retrieving information relating to the community of the other of the initiator and the respondent.

3. (Currently Amended) The method of claim 1, wherein the received information includes at least one factor and an evaluation of [[the]] a desirability or a cost of the at least one factor.

4. (Original) The method of claim 3, wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome.

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5. (Currently Amended) The method of claim 1, further comprising iteratively receiving, at the system computer, factors relating to the dispute from the other of the initiator computer and the respondent computer.
6. (Currently Amended) The method of claim 1, further comprising iteratively receiving evaluations of ~~[[the]]~~ a desirability or a cost of the portions of iteratively provided information from the other of the initiator computer and the respondent computer.
7. (Original) The method of claim 1, further comprising automatically proposing an agreement to resolve the dispute based on the received information.
8. (Currently Amended) The method of claim 7, wherein the agreement is automatically proposed in accordance with factors relating to the dispute received from the other of the initiator computer and the respondent computer.
9. (Currently Amended) The method of claim 8, wherein the agreement is automatically proposed by the system computer in accordance with ~~[[an]]~~ a received evaluation of desirability from the initiator computer or the respondent computer and ~~[[an]]~~ a received evaluation of cost from the other of the initiator computer or the respondent computer, the evaluations being associated with the same portion of the dispute related information or the same dispute related factor.
10. (Currently Amended) The method of claim 1, further comprising automatically providing advice from the system computer to the other of the initiator computer and the respondent computer based on iteratively provided information.

11. (Previously Presented) An apparatus for managing a dispute about a pre-existing agreement, comprising:

a computer for automatically receiving information relating to the dispute from one of an initiator and a respondent, the initiator and the respondent being parties to the agreement, and for iteratively providing portions of the information to the other of the initiator and the respondent in accordance with predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator or the respondent, or relating to the number of portions of the information to be provided at an iteration.

12. (Original) The apparatus of claim 11, wherein the computer is also for automatically retrieving information relating to the community of the other of the initiator and the respondent.

13. (Original) The apparatus of claim 11, wherein the received information includes at least one factor and an evaluation of the desirability or cost of the factor.

14. (Original) The apparatus of claim 13, wherein the at least one factor includes at least two of historical harm, future harm, an incentive, a punishment, a request, an offer, and a desired outcome.

15. (Original) The apparatus of claim 11, wherein the computer is also for iteratively receiving factors relating to the dispute from the other of the initiator and the respondent.

16. (Original) The apparatus of claim 11, wherein the computer is also for iteratively receiving evaluations of the desirability or cost of the portions of iteratively provided information from the other of the initiator and the respondent.

17. (Original) The apparatus of claim 11, wherein the computer is also for automatically proposing an agreement to resolve the dispute based on the received information.

18. (Original) The apparatus of claim 17, wherein the agreement is automatically proposed in accordance with factors relating to the dispute received from the other of the initiator and the respondent.

19. (Original) The apparatus of claim 18, wherein the agreement is automatically proposed in accordance with an evaluation of desirability from the initiator or the respondent and an evaluation of cost from the other of the initiator or the respondent, the evaluations being associated with the same portion of the dispute related information or the same dispute related factor.

20. (Original) The apparatus of claim 11, wherein the computer is also for automatically providing advice to the other of the initiator and the respondent based on iteratively provided information.

REMARKS

This paper responds to the *Examiner's Answer (Answer)*, mailed December 11, 2008. Appellants have presently amended claims 1, 3, 5, 6, and 8-10. No claims are canceled or added. Consequently, claims 1-20 remain pending in this application.

In the *Answer*, the Examiner maintained the rejection of claims 1-8, 10-18, and 20 under 35 U.S.C. §103(a) as being obvious under U.S. Patent No. 6,553,347 to Tavor et al. (*Tavor*) in view of U.S. Patent No. 6,556,974 to D'Alessandro (*D'Alessandro*)¹. The Examiner also rejected claims 1-10 on new grounds under 35 U.S.C. § 101 as being directed to non-statutory subject matter².

Rejection of Claims under 35 U.S.C. §101

On page 6 of the *Answer*, the Examiner rejected claims 1-10 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Specifically, the Examiner stated that

[A] §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or being. . . . In this particular case, claims [1-10] fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. (*Answer* at 6-7 (citing *In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008)).)

In light of the present amendments to claims 1, 3, 5, 6, and 8-10, Appellants respectfully submit that independent claim 1 is directed to statutory subject matter. Furthermore, because claims 2-10 depend, either directly or indirectly, from claim 1, claims 2-10 are also directed to statutory subject matter.

Claim 1, as amended, recites, a method comprising, *inter alia*,

automatically receiving, ***over a network by a system computer***, information relating to the dispute, the information being generated from one of ***an initiator computer*** associated with an initiator and ***a respondent computer*** associated with a respondent, the initiator and

¹ *Answer*, page 4, paragraph 3.

² *Answer*, page 6.

the respondent being parties to the agreement; and

iteratively providing portions of the information *to the other of the initiator computer and the respondent computer* in accordance with predetermined criteria, the predetermined criteria relating to either a rating of a portion of the information supplied after a start of the dispute by the initiator the respondent, or relating to the number of portions of the information to be provided at an iteration. (Emphasis added.)

Claim 1 thus recites a method of receiving information “over a network at a system computer.” The information is sent either “from an initiator computer” or “from a respondent computer.” Claim 1 also recites a method of “providing portions of the information to the other of the initiator computer and the respondent computer.” “[A] process claim satisfies § 101 . . . [if the] claim is tied to a particular machine.” *In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Since claim 1 is tied to a particular machine, for example, to a system computer, a network, an initiator computer, and a respondent computer, Appellants respectfully submit that amended independent claim 1 satisfies any requirements of 35 U.S.C. § 101. Furthermore, because claims 2-10 depend, either directly or indirectly, on claim 1, claims 2-10 are also directed to patentable subject matter. Therefore, Appellants respectfully request that the rejection made under 35 U.S.C. § 101 with respect to claims 1-10 be reconsidered and withdrawn.

Rejection of Claims under 35 U.S.C. §103(a)

On page 6 of the *Answer*, the Examiner rejected independent claims 1 and 11 under 35 U.S.C. §103(a) as being obvious by *Tavor* in view of *D'Alessandro*. In the recent U.S. Supreme Court case *KSR International Co. v. Teleflex Inc.*, the Supreme Court discussed obviousness determinations.

The rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods with *no change in their respective functions*, and the combination would have yielded *nothing more than predictable results* to one of ordinary skill in the art. (*KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); *See also* MPEP § 2143.) (Emphasis added.)

Appellants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Appellants' claimed elements, with no change in the respective functions of the cited references, nor is there any substantiating evidence that the combination of the references would have yielded anything more than predictable results. "If ***any of these [three] findings*** cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."³

Independent claim 1 recites, a method of managing a dispute about a pre-existing agreement comprising, *inter alia*,

[A]utomatically receiving, over a network at a system computer,
information relating to the dispute . . . and

iteratively providing portions of the information to the other of the initiator computer and the respondent computer in accordance with predetermined criteria. (Emphasis added.)

Appellants' other independent claim, namely claim 11, shares similar limitations with claim 1.

The *Answer* fails to allege with any specificity that *Tavor* discloses "receiving . . . information relating to the dispute [about a pre-existing agreement]," but simply broadly states that *Tavor* contemplates such information. The Examiner cites to *Tavor* at col. 4, lines 20-41, to disclose "receiving . . . information relating to the dispute." However, that section of *Tavor* discusses "conducting 'one to one' commercial negotiations," particularly as they relate to purchase price negotiations⁴. Arguing over a purchase price may be considered a dispute of sorts, but it is not a dispute about a "pre-existing agreement" as is recited in the pending claims. Therefore, *Tavor* cannot fairly be held to disclose the claimed element of "receiving . . . information relating to the dispute [about a pre-existing agreement]." Similarly, *Tavor* also fails to disclose "iteratively providing portions of the information [relating to the dispute about a pre-existing agreement]."

³ MPEP § 2143, emphasis added.

⁴ See *Tavor*, col. 4, lines 20-21.

Further, because claims 2-8, 10, 12-18, and 20 depend, either directly or indirectly, from claims 1 and 11, they are also non-obvious for at least the same reasons as set forth for independent claims 1 and 11. MPEP § 2143.03 (citing *In re Fine*, 827, F.2d 1071 (Fed. Cir. 1988)). Further, each of the dependent claims may contain additional patentable subject matter. Therefore, Appellants respectfully request that the rejection made under 35 U.S.C. § 103(a) with respect to claims 1-8, 10-18, and 20 be reconsidered and withdrawn.

Claims 9 and 19

Appellants thank the Examiner for recognizing the non-obvious nature of claims 9 and 19. Since neither of these dependent claims was rejected under 35 U.S.C. §103(a), and Appellants have shown that claim 9 is now patent-eligible under 35 U.S.C. §101, Appellants assume each of these claims would separately be allowable if re-written in independent form.

CONCLUSION

Appellants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

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By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of August, 2009.

Chris Bartl

Name


Signature